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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	10/716,082
		Filing Date	11/17/2003
		First Named Inventor	Keif M. Fitzgerald
		Art Unit	3738
		Examiner Name	Thomas Sweet
Total Number of Pages in This Submission	14	Attorney Docket Number	ENDOS-66188

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Postcard
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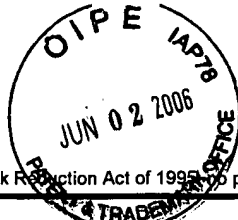
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Firm Name	FULWIDER PATTON LLP		
Signature			
Printed name	John V. Hanley		
Date	5/30/2006	Reg. No.	38,171

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FEE TRANSMITTAL for FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$500.00

Complete if Known

Application Number 10/716,082
 Filing Date 11/17/2003
 First Named Inventor Keif M. Fitzgerald
 Examiner Name Thomas Sweet
 Art Unit 3738
 Attorney Docket No. ENDOS-66188

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 06-2425 Deposit Account Name: Fulwider Patton LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid(\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims Extra Claims Fee (\$) Fee Paid (\$)
 - 20 or HP = _____ x \$50.00 = \$0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)
 - 3 or HP = _____ x \$200.00 = \$0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listing under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)
 - 100 = 0 / 50 0 (round up to a whole number) x \$250.00 = \$0.00

4. OTHER FEE(S)

Non-English specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

\$500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	38,171	Telephone	310-824-5555
Name (Print/Type)	John V. Hanley			Date	5/30/2006

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John V. Henley, Reg. No. 38,171

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of

Inventor: Keif M. Fitzgerald, et al.

Serial No. 10/716,082

Filed: November 17, 2003

For: APPARATUS AND METHOD FOR
DEPLOYING SELF-EXPANDING STENTS

Date: May 30, 2006

Examiner: Thomas Sweet

Group Art Unit: 3738

Client ID/Matter No. ENDOS-66188

APPELLANT'S BRIEF

MS: Appeal Brief Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appellant's Brief is being filed along with the fees required under § 1.17 in response to the final Office action dated September 30, 2005 and the Advisory Action dated February 27, 2006 which maintained the final rejections of the claims. In the event additional fees are required, authorization is hereby provided to charge our Deposit Account No. 06-2425 any fees due in connection with this paper.

This brief contains items under the following headings, and in the order set forth below:

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- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED INVENTION
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: EndoVascular Technologies, Inc., 3200 Lakeside Drive, Santa Clara, CA 95054.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly effect, or be directly effected by, or have a bearing on the Board's decision on this appeal, it is to be noted that is believed there are no such appeals or interferences known to the Applicant.

III. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total Number of Claims in the Application

The claims in the application are: Claims 10-20 and 24-33

B. Status of All of the Claims

Each of pending claims 17-20 and 24-33 stand as finally rejected under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a). Claims 10-16 have been withdrawn from consideration.

C. Claims on Appeals

The claims on appeal are each of pending claims 17-20 and 24-33.

IV. STATUS OF AMENDMENTS

In the final Office action dated September 30, 2005, claims 17, 18 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Whitehouse et al. (4,743,265; Exhibit A) and claims 24-26 appear to also have been rejected under § 102(b) in view of Whitehouse et al. Additionally, claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse et al. in view of Hakky et al. (6,113,577; Exhibit B); claims 29-33 were rejected under § 103(a) as being unpatentable over Whitehouse et al. in view of Burgermeister as applied to claims 27 and 28 and further in view of Gellman et al. (2002/0055748; Exhibit C); and claims 27 and 28 were rejected under § 103(a) as being unpatentable over Whitehouse et al. in view of Burgermeister (2004/0193205; Exhibit D).

V. SUMMARY OF CLAIMED INVENTION

The presently claimed invention relates to a catheter including an elongated catheter member 12, a catheter handle 22 secured to the catheter member 12 and a platform 60 removably secured to the catheter handle 22 (See page 13, line 14 et seq., FIGS. 8 and 9).

In one particular aspect, the removable platform 60 can include grooves 66 which are configured to receive tracks 68 running along an edge of the catheter handle 27. In this way the

removable platform 60 can be slidably secured to the catheter handle (See page 13, line 29 et seq. and FIG. 10).

Moreover, the presently claimed invention is directed towards a catheter assembly further including a slider knob 30 that activates a cutter or blade 24. The cutter is configured to be slideable with respect to the handle 22 and catheter 12 as well as to longitudinally dissect an outer member 16 of the catheter 12 (See FIGS. 1 and 2 and page 8, line 7 et seq.).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 17, 18, 20, 24, 25 and 26 were improperly rejected under 35 U.S.C. § 102(b) as being anticipated by Whitehouse et al. (4,743,265). Additionally, whether claim 18 was improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse et al. in view of Hakky et al. (6,113,577); whether claims 27 and 28 were improperly rejected under § 103 as being unpatentable over Whitehouse et al. in view of Burgermeister (2004/0193205); and whether claims 29-33 were improperly rejected under § 103(a) as being unpatentable over Whitehouse et al. in view of Burgermeister as applied to claims 27 and 28 and further in view of Gellman et al. (2002/0055748).

VII. ARGUMENT

A. § 102(b): Claims 17, 18, 20, 24, 25 and 26

In rejecting the claims under § 102(b) in view of Whitehouse et al., the Examiner stated that base member 12 was removably secured to a handle 14 and 16 and referred the Applicants to FIG. 3 as support for the same. Significantly, independent claim 17 and each of the dependent claims 18-19 and 24-33 recite a catheter comprising a catheter handle and a platform removably

secured to the catheter handle. Dependent claim 20 further limits claim 17 by requiring that the removable platform be slidably secured to the catheter handle.

It is respectfully submitted, however, that the Whitehouse et al. patent does not teach a platform removably secured to a catheter handle nor an arrangement involving the removable platform being slidably secured to the catheter handle. On the contrary, the Whitehouse et al. reference merely discloses a base member 12 including a housing 36 against which recesses 56A and 56B of handles 14 and 16 are placed. Clearly, such an arrangement does not involve removably securing the handles 14 and 16 to the base 12. That is, placing one item against another does not constitute securing the items together. Moreover, should an individual pick up the handles 14 and 16 of Whitehouse, et al. the base 12 would not remain secured to the handles 14 and 16 as one would expect of items which are secured to each other.

In fact, the base (12) of Whitehouse et al. is used as a stabilizer and permits the handles (14, 16) to rotate with respect thereto. Additionally, member (20) is actually threaded through the base (12) and is not secured to the handles (14, 16) since it is independently placed within vasculature and thereafter split by the handles (14, 16) to disjoin it from the catheter (18) (See column 6, lines 9 et seq.). The Applicants also believe it is noteworthy that reference numeral 18 of Whitehouse et al. is actually a needle and as such arguably does not form part of the catheter or structure required by the claims.

Accordingly, it is respectfully submitted that independent claim 17 and dependent claims 18-20 and 24-33 define patentable subject matter.

B. § 103(a): Claims 19, 27 and 29-33

Turning now to the rejections of the claims under § 103(a), it is respectfully submitted that the combination of the Whitehouse et al. and Hakky et al. references, the combination of the

Whitehouse et al. and Burgermeister references and the combination of the Whitehouse et al. Burgermeister and Gellman et al. references were made through improper hindsight.

Notably, MPEP 2145 states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine referenced teachings. It is additionally required under MPEP 2143.01 that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time that the claimed invention was made' because the references relied upon teach all the aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine the references."

In rejecting the claims under § 103, it is respectfully submitted that the Examiner found little or no motivation or suggestion in the references themselves to combine their respective teachings but rather, selected features of one reference and added such features to the teachings of one or more references based upon what the Examiner proffered to be something which would be obvious to one of ordinary skill in the art. As it is believed to be improper to place such heavy reliance upon what the Examiner believes to be the level skill in the art, it is respectfully submitted that the claims are not obvious in view of the cited art.

Moreover, the combination of Whitehouse et al., Burgermeister and Gellman et al. employed by the Examiner to reject claims 29-33 appears to be particularly tenable. In so

rejecting the claims, the Examiner stated that one of ordinary skill in the art would have taken a first step to modify the teachings of the Whitehouse et al. reference to include a knob disclosed in the Burgermeister reference. The Examiner then stated that one of ordinary skill in the art would have taken a second step to modify the combined teachings of the Whitehouse et al. and Burgermeister references to include a cutter disclosed by the Gellman et al. reference. The Examiner then stated that it would have been obvious to one of ordinary skill in the art to require the cutter taken from Gellman et al. and incorporated into the combined teaching of the Whitehouse et al. and Burgermeister references, to be configured so that it could be maneuvered to protrude from a distal tip of a catheter. Further, the Examiner also stated that it would have been of ordinary skill in the art to configure the Gellman et al. cutter to dissect an outer member of a catheter.

Again, it is respectfully submitted that such heavy reliance on what one of ordinary skill in the art would presumably do is improper in view of the guidelines provided by the MPEP. Further, even it was proper to so rely on the level of the skill in the art, one of ordinary skill in the art would not take the multiple steps required to meet the limitations recited in claims 29-33. In fact, since the Gellman et al. patent is concerned with cutting tissue, it is not believed that one of ordinary skill in the art would have been inclined to combine the teachings of the Gellman et al. patent with that of Whitehouse et al. and Burgermeister patents.

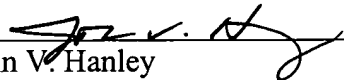
Accordingly, it is believed that claims 29-33 are allowable for these reasons as well.

CONCLUSION

For all the reasons stated above, Applicant respectfully submits that the Examiner has erred in rejecting claims 17-20 and 24-33. It is respectfully requested that the Board reverse the rejection of claims 17-20 and 24-33 and pass claims 17-20 and 24-33 to issue.

Respectfully submitted,

FULWIDER PATTON LLP

By:  _____
John V. Hanley
Registration No. 38,171

JVH/kst
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201
127521.1

VIII. CLAIMS

Claims 1-9 (canceled)

Claim 10 (withdrawn): A method for adjusting the length of a stent delivery catheter, comprising:

providing a stent delivery catheter having a handle, an inner member, and an outer member and a platform removably attached to the handle;

cutting the catheter outer member along a first cutting line extending generally longitudinally along the length of the catheter outer member, whereby the catheter outer member is split along the first cutting line; and

peeling the catheter outer member away from the catheter inner member, whereby the catheter outer member is peeled along the first cutting line.

Claim 11 (previously presented): The method of claim 10, wherein the catheter inner member has a distal end and a proximal end, the method further comprising:

cutting off a selected portion of the catheter inner member, wherein the selected portion is adjacent to the catheter inner member proximal end.

Claim 12 (withdrawn): The method of claim 10, further comprising:

cutting the catheter outer member along a second cutting line extending generally longitudinally along the length of the catheter outer member, whereby the catheter outer member is split along the second cutting line.

Claim 13 (withdrawn): The method of claim 12, whereby the second cutting line extends generally parallel to the first cutting line.

Claim 14 (withdrawn): The method of claim 10, wherein the stent delivery catheter comprises a first cutting device in engagement with the catheter outer member, wherein cutting the catheter outer member along the first cutting line comprises:

sliding the first cutting device along the catheter with the first cutting device engaging the catheter outer member along the first cutting line, whereby the catheter outer member is split along the first cutting line.

Claim 15 (withdrawn): The method of claim 14, wherein the stent delivery catheter comprises a second cutting device in engagement with the catheter outer member, the method further comprising:

sliding the second cutting device along the catheter outer member along a second cutting line extending generally longitudinally along the length of the catheter outer member, whereby the catheter outer member is split along the second cutting line.

Claim 16 (withdrawn): The method of claim 10, wherein the stent delivery catheter comprises a first cutting device and a second cutting device, with the first cutting device and the second cutting device both secured to a slider mechanism slidably disposed on the catheter outer member, the method comprising:

sliding the slider mechanism along the catheter outer member with the first cutting device engaging the outer member along a first cutting line and with the second cutting device engaging the outer member along a second cutting line, whereby the catheter outer member is split into two halves defined by the first cutting line and the second cutting line.

Claim 17 (previously presented): A catheter comprising:

an elongated catheter member having a distal end and a proximal end;

a catheter handle secured to the elongated catheter member; and

a platform removably secured to the catheter handle.

Claim 18 (previously presented): The catheter of claim 17, wherein the removable platform comprises protruding stabilizers.

Claim 19 (previously presented): The catheter of claim 17, wherein the removable platform has a lower surface that is generally curved.

Claim 20 (previously presented): The catheter of claim 17 wherein the removable platform is slidably secured to the catheter handle.

Claims 21-23 (canceled)

Claim 24 (previously presented): The catheter of claim 17, wherein the elongated catheter member includes an inner member and an outer member.

Claim 25 (previously presented): The catheter of claim 24, wherein the catheter handle is slideable with respect to the outer member.

Claim 26 (previously presented): The catheter of claim 25, wherein the catheter handle includes structure securing the catheter handle to the outer member.

Claim 27 (previously presented): The catheter of claim 26, wherein the handle further includes a knob, the knob being slideable with respect to the handle.

Claim 28 (previously presented): The catheter of claim 27, wherein the knob is attached to the outer member.

Claim 29 (previously presented): The catheter of claim 28, wherein the catheter handle further includes a cutter, the cutter configured within an interior of the catheter handle.

Claim 30 (previously presented): The catheter of claim 29, wherein the cutter is slideable with respect to the catheter handle.

Claim 31 (previously presented): The catheter of claim 30, wherein the cutter is attached to the knob.

Claim 32 (previously presented): The catheter of claim 31, wherein the cutter is slideable with respect to the outer member.

Claim 33 (previously presented): The catheter of claim 32, wherein the cutter is configured to longitudinally dissect the outer member.